

Serial No. 09/859,416
HP 30002022-3
LHB 1509-176
Page 13

REMARKS

Applicant does not understand the objection to the numbering of the claims set forth in the first full paragraph on page 2 of the Office Action. At the time the Preliminary Amendment was filed in May 2001, the current requirement for listing all claims in an Amendment did not exist and was rarely performed by Applicants in connection with Amendments. There has been no renumbering of the claims, and the claims in the application as filed and as presented in the Preliminary Amendment are correctly numbered. If this objection is repeated, the Examiner is requested to more specifically indicate why the claims are not correctly numbered.

Claims 1, 3, 4, 12, 13, 19, and 23 are amended for various reasons, including clarity and to assure open-ended coverage.

Applicant traverses the rejection of claim 1 as being anticipated under 35 U.S.C. §102(e) by Manico et al. (U.S. 6,322,260). Claim 1 is not anticipated because it is directed to a method of selecting prints of photographs from a digital film medium. The steps of the claim are directed to operations associated with the digital film medium. For example, a selection of thumbnail representations of photographs available on the digital film medium is required to be printed. One or more

Serial No. 09/859,416

HP 30002022-3

LHB 1509-176

Page 14

actions relating to the photographs stored on the digital film medium are also required to be performed.

Manico does not disclose a digital film medium. Applicant's specification as filed defines on page 1, lines 9-11, a digital film medium as a storage medium used by digital cameras comprising Smart Media, Compact Flash, or other types of solid-state storage cards. As stated in the middle paragraph on page 3 of the Office Action, the Manico reference discloses developing film from a photosensitive medium. Manico discloses in FIG. 1 an apparatus wherein photographic film 13 is wound from cartridge 18 through a processing path 34. The processing path includes a station for supplying a processing solution on donor web 24 to film 13. The film is developed by using developing chemistry (Manico, column 5, lines 34 and 35). After the film has been developed, the film is rewound back onto film cartridge 18, and the developed images pass digital scanner 40.

Because the digital film medium requirement of claim 1 is not found in Manico and a proper rejection under 35 U.S.C. §102(e) requires all features of a claim to be disclosed in a single reference, claim 1 is not anticipated by Manico et al.

The rejection of the remaining claims, based on obviousness under 35 U.S.C. §103, does not consider the digital film medium

Serial No. 09/859,416

HP 30002022-3

LHB 1509-176

Page 15

limitation that is in all of the claims. Consequently, none of the claims is properly rejected either on Manico or Manico in combination with the applied secondary references, i.e., Lee et al. (U.S. 6,264,384) or Lesnick et al. (U.S. 4,760,606).

Based on the foregoing, the rejection of claims 2-10, 12, 13, 16-20 and 22 as being obvious as a result of Manico is incorrect. In addition, many of these claims define features that are not obvious as a result of Manico, despite the allegations in the Office Action to the contrary.

In the Manico device, printer 80 responds to digital scanner 40 to produce receipt 81, FIG. 11. In addition, scanner 40 activates cathode ray tube 42, which displays the images on film 13 so a user can see the images. The display includes operator controlled options, as illustrated in FIG. 10g. The user selects one of the options; note the indicia on the display that says, "Select an option:". In response to the user selecting one of the options, the selected option is performed, either at a remote location, or at the same location as the apparatus illustrated in FIG. 1, by using the apparatus illustrated in FIGS. 13-16 of Manico. The options on the display of FIG. 10g form the basis for subsequent operations in response to the user input, rather than

Serial No. 09/859,416
HP 30002022-3
LHB 1509-176
Page 16

the receipt of FIG. 11 that is merely inserted through slot 110 of Manico.

Manico has no disclosure of any apparatus for interpreting the marking on the "select" box of the receipt or what happens to the receipts that are dropped through slot 110. Column 10, line 26, merely states that slot 110 is a slot for order form 106 for reading and placement of the order. There is no indication that the reading and placement of the order are as a result of any structure included in device 10. It is possible and, perhaps, likely that the reading and placement of the order are performed manually at the remote location.

Because display 42 includes selections and order form 106 includes only a single select box, it would not have been obvious to one of ordinary skill in the art to modify the Manico order form to include a plurality of select fields for designating a print format which the photograph represented by the thumbnail representation is to be printed, as claim 3 requires. Similarly, it would not have been obvious to one of ordinary skill in the art to have modified Manico to include the requirement of claim 4 for a plurality of selection fields that designate the number of prints of photographs corresponding to a particular thumbnail representation to be printed.

Serial No. 09/859,416

HP 30002022-3

LHB 1509-176

Page 17

Because Manico develops photographic film that is paid from a cartridge during the developing process and then is returned to the cartridge after the developing process has been completed, Manico would not have included a deletion field, as set forth in claim 5 or performed the delete operation, which claim 5 indicates is performed during step (iv) of claim 1. Once the developed image has been formed on photograph film 13, removal of such an image is, at best, difficult. There is no reason to remove a developed image from photographic film because there is nothing to be gained from such a deletion. In contrast, deleting images from digital film has the advantage of enabling additional images to be stored on the digital film. Consequently, the requirement of claim 5 is not rendered obvious by Manico.

Concerning claim 7, there is no disclosure in Manico of terminating the method if the identifier on receipt 81 does not correspond to a unique identifier allocated to the Manico film medium. The unique order number 108 on receipt 81 is merely for identification purposes. There is no disclosure of this number being used to terminate the Manico developing process. Indeed, it is too late to terminate the Manico developing process if the unique order number does not correspond to a unique identifier allocated to the Manico film. This is because the film has

Serial No. 09/859,416

HP 30002022-3

LHB 1509-176

Page 18

already been developed by the time the image is read by digital scanner 40, as the film is being returned to cartridge 18 after having gone through film processing section 26.

Manico does not render the requirement of claim 10 obvious. Claim 10 indicates that step (iii) of claim 1, relating to determining which selection field has been marked, is determined by scanning the marked selection sheet. The discussion of claim 10 in the Office Action is not applicable to the selection field of form 106. Manico has no information as to how form 106 is processed after the form has been passed through slot 110. In this regard, see the previous discussion concerning slot 110. Consequently, there is no basis in Manico for the position in the Office Action that Manico discloses or makes obvious a scanner for determining which selection field on form 106 has been marked.

Concerning the rejection of claim 12, Manico has no disclosure of a digital film medium interface because Manico fails to disclose a digital film medium. The Office Action ignores the digital film medium requirement of claim 12.

The rejection of claim 13 as being obvious as a result of Manico is also incorrect because claim 13 is directed to a digital film-enabled printer including a first interface for reading data from a digital film medium. Claim 13 also includes the

Serial No. 09/859,416

HP 30002022-3

LHB 1509-176

Page 19

requirement for a processor arranged for processing data from a detector for enabling a user marked selecting sheet input to the printer **via the printer feed path** to be inspected. The requirement for "via the printer feed path" is ignored in the Office Action. Further, Manico does not include such a requirement. Receipt 81 is printed by printer 80 and is inserted into slot 110. There is no information in Manico indicating that the receipt, after having been inserted through slot 110, passes back through printer 80.

Because claim 13 is improperly rejected as being obvious as a result of Manico, the rejection of claims 16-20 and 22, all of which depend on claim 13, is incorrect. In addition, the rejections of claims 16-19 as being obvious as a result of Manico are improper for the same reasons discussed *supra* in connection with claims 3-5.

Applicant traverses the rejection of claims 14 and 15 as being obvious as a result of Manico and Lee et al. These claims are allowable for the same reasons advanced for the claims upon which they depend, because Lee et al. obviously does not cure the foregoing insufficiencies. In addition, applicant cannot agree with the Examiner's statement in the rejection of claim 14 that there should be some mechanism to read the order sheet in Manico.

Serial No. 09/859,416

HP 30002022-3

LHB 1509-176

Page 20

As previously discussed, the order sheet could be read manually. Further, there is no basis for the Examiner to conclude that the scanner would be in the printer 80 of Manico. Manico merely shows printer 80 as being a box in a housing. The box is not in a position such that a sheet being fed through slot 108 could pass through the printer. The Examiner is using hindsight to assert that it would have been obvious for a scanner to be on the printer of Manico. Claim 15 is even more specific by requiring the scanning mechanism to be attached to the print head being movable transversely across the feed path in response to the signals from the processor. Clearly, the Examiner has merely cast around to find the features of Applicant's claims and, after finding these features, asserted they are obvious.

Applicant traverses the rejection of claims 11, 21 and 23 as being obvious as a result of Manico in view of Lesnick et al. Claims 11 and 21 are dependent claims and are allowable for the same reasons advanced for the claims upon which they depend, since Lesnick et al. does not cure the above-noted deficiencies of the independent claims. In addition, the Office Action ignores a requirement of claim 11, requiring in step (iii) inspection of **only** those parts of the selection sheet corresponding to the selection fields. There is no indication in the Office Action

Serial No. 09/859,416
HP 30002022-3
LHB 1509-176
Page 21

that Lesnick et al. includes the foregoing feature. Clearly, it is not found in Manico.

Modification of Manico as a result of Lesnick et al. to meet the requirements of claim 21 is nonsense. As previously pointed out, all the images are formed on the developed film by the time receipt 81 is printed. Consequently, there is no point in modifying Manico to include inhibiting one or more actions if the unique sheet identifier does not correspond to a unique identifier of the film medium, as claim 21 requires. Further, there is no disclosure in either reference of a digital film medium, as claim 21 requires.

Applicant cannot agree with the position set forth in the Office Action regarding the requirements of claim 23 for feeding the marked selection sheet into the printer feed path for scanning by the scanning mechanism to detect which selection fields have been marked. The comment in the last full sentence on page 23 of the Office Action is not germane to claim 23:

Although Manico et al does not go into further detail, it would make sense to feed the order sheet to the printer since one would want to print the selected images

This comment is not germane to claim 23 because claim 23 requires the marked selection sheet to be fed into the printer

Serial No. 09/859,416

HP 30002022-3

LHB 1509-176

Page 22

feed path for scanning by the scanning mechanism to detect which of the selection fields has been marked. The Examiner's comment appears only to concern feeding a blank order sheet to a printer.

Claims 24-30 have been added to provide Applicant with the protection to which he is deemed entitled. Claim 24 distinguishes over the prior art, *inter alia*, by requiring a digital film medium to be inserted into a reader and by causing a reader to read images on the digital film medium. Claim 25 requires the images that are transferred to the sheet by causing the sheet to move relative to the printer via a predetermined path and further requires the sheet, when reinserted into the apparatus, to move relative to the detector via the same predetermined path. Claim 26 indicates the selection field includes a delete section. The image associated with "delete selection" being marked is deleted from the digital film medium in response to the "read delete" selection marking.

Claim 28 is directed to a method of deleting an image carried by a digital film medium, an operation that is completely missing from the art of record.

Claims 27 and 29 are directed to apparatus included in method claims 24 and 28, further in combination with processors for performing steps set forth in claims 24 and 28.

*Serial No. 09/859,416**HP 30002022-3**LHB 1509-176**Page 23*

Claim 30 is directed to a sheet having plural thumbnail photographs of images carried by a digital film medium, wherein each of the thumbnail photographs is associated with a selection field include a delete entry. The delete entry is positioned and arranged on the sheet so that in response to the delete entry being marked, a detector for markings on the sheet causes a processor to remove the image associated with the marked delete entry from the digital film medium.

In view of the foregoing amendments and remarks, allowance is in order.

To the extent necessary during prosecution, Applicant hereby requests any required extension of time not otherwise requested and hereby authorizes the Commissioner to charge any prescribed fees not otherwise provided for, including application processing,

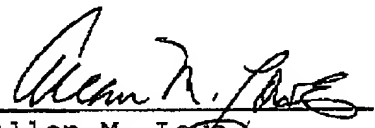
Serial No. 09/859,416
HP 30002022-3
LMB 1509-176
Page 24

extension of time, and extra claims fees, to Deposit Account No.
08-2025.

Respectfully submitted,

JOHN WILLIAM LUMLEY

By:


Allan M. Lowe
Reg. No. 19,641

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P. O. Box 272400
Fort Collins, CO 80527-2400
703-684-1111 telephone
970-898-0640 telecopier
AML:alw:rk

CERTIFICATION OF FACSIMILE TRANSMISSION
I HEREBY CERTIFY THAT THIS PAPER IS BEING FACSIMI-
LE TRANSMITTED TO THE PATENT AND TRADEMARK OFFICE
ON THE DATE SHOWN BELOW

Rosanna Kaplan
TYPE OR PRINT NAME OF PERSON SIGNING CERTIFICATION
ML 2-28-05
SIGNATURE DATE
703-872-9306
FACSIMILE NUMBER